

Practitioner's Docket No. P-1263

**CHAPTER II**

**IN THE UNITED STATES ELECTED OFFICE (EO/US)**

PCT/EP2004/000071 ✓      8 JANUARY 2004 ✓      8 JANUARY 2003 ✓  
INTERNATIONAL APPLICATION NO.      INTERNATIONAL FILING DATE      PRIORITY DATE CLAIMED

**MASTER BATCHES BASED ON PRE-EXFOLIATED NANOCOLAYS AND THE USE OF THE SAME ✓**  
TITLE OF INVENTION

HEINZ-DIETER METZEMACHER, RAINER SEELING ✓  
APPLICANT(S)      U.S. APPLICATION NO. 10/541,625 ✓      CONFIRMATION NO. 8299 ✓  
                      U.S. FILING DATE: JULY 6, 2005 ✓

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

NOTE (FACSIMILE): While the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.495(b), may NOT be submitted by facsimile subsequent correspondence may be transmitted by facsimile in an application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Examining Authority, but it will NOT receive the benefit of any certificate of transmission (or mailing). The PCT facsimile number is 703-305-3230. Notice of July 12, 2005 (1296 OG 76), "New Patents Central FAX Number and Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence."

**EXPRESS MAILING UNDER 37 C.F.R. § 1.10\***

(Express Mail label number is mandatory.)  
(Express Mail certification is optional.)

I hereby certify that this paper, along with any document referred to, is being deposited with the United States Postal Service on this date March 8, 2006, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 as "Express Mail Post Office to Addressee" Mailing Label No. EQ 069676229 US

HOLLY HART

(type or print name of person mailing paper)

Holly Hart

Signature of person certifying

**WARNING:** Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

**\*WARNING:** Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

**COMPLETION OF FILING REQUIREMENTS  
FOR INTERNATIONAL APPLICATION ENTERING U.S. NATIONAL STAGE  
IN U.S. ELECTED OFFICE (EO/US) UNDER 35 U.S.C. § 371**

(check and complete the applicable item, if applicable)

This replies to the Notice of Missing Requirements under 35 U.S.C. § 371 and 37 C.F.R. § 1.495 (FORM PCT/DO/EO/905).

A copy of FORM PCT/DO/EO/905 accompanies this response.

**WARNING:** Where the items being submitted to complete the entry of the international application into the national phase are subsequent to 30 months from the priority date the application is still considered to be in the international state and if mailing procedures are utilized to obtain a date the express mail procedure of 37 C.F.R. § 1.10 must be used (because international application papers are not covered by an ordinary certificate of mailing. 37 C.F.R. § 108(2)(xi)).

**NOTE:** Documents and fees must be clearly identified as a submission to enter the national stage under 35 U.S.C. § 371. Otherwise, the submission will be considered as being made under 35 U.S.C. § 111. 37 C.F.R. § 1.495(g).

**DECLARATION OR OATH**

**NOTE:** 37 C.F.R. § 1.495(c): "If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date but omits . . . the oath or declaration of the inventor (35 U.S.C. 371(c)(4) and § 1.497), if a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, applicant will be so notified and given a period of time within which to file the . . . oath or declaration in order to prevent abandonment of the application. . . . The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of thirty months after the priority date."

I.  No original declaration or oath was filed. Enclosed is the original declaration or oath for this application.

**OR**

The declaration or oath that was filed was determined to be defective. A new original oath or declaration is attached.

**NOTE:** For surcharge fee for filing declaration after filing date complete item IV(2).

**NOTE:** Acceptable minimums in the declaration in an ordinarily filed U.S. application for identification of the specification to which it applies are:

(A) application number (consisting of the series code and the serial number, e.g., 08/123,456);  
(B) serial number and filing date;

(C) attorney docket number which was on the specification as filed;

(D) title which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(E) title of the inventor which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the PTO is the application which the inventor(s) executed by signing the oath or declaration.

M.P.E.P. § 602, 8th ed.

**NOTE:** Another minimum found acceptable in the declaration is the filing date (i.e., date of express mail) and the express mail number, useful where the serial number is not yet known. But note the practice where the express mail deposit is a Saturday, Sunday or holiday within the District of Columbia. 37 C.F.R. § 1.10(c).

**NOTE:** See 37 C.F.R. § 1.41(a).

The original oath was objected to. A new original oath is attached.

(complete as applicable)

Attached is a

- (a)  Statement by a registered attorney that the application filed in the PTO is the application that the inventor executed by signing the declaration.
- (b)  Statement that the "attached" specification is a copy of the specification and any amendments thereto that were filed in the PTO to obtain the filing date.
- (c)  Statement that substitute specification contains no new matter.
- (d)  Preliminary amendment
- (e)  Transmittal of Formal Drawings Prior to Notice of Allowance
- (f)  Submission of "Sequence Listing," computer readable copy, and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

### **AMENDMENT**

**II.**

*(complete as applicable)*

- An amendment in accordance with 37 C.F.R. § 1.121 is attached.
- The attached amendment cancels claims \_\_\_\_\_ inclusive.

### **TRANSMITTAL OF ENGLISH TRANSLATION OF NON-ENGLISH LANGUAGE PAPERS**

**III.**  Submitted herewith is an English translation of the non-English language international application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO. (See 37 C.F.R. § 1.495(c))

*NOTE: For fee for processing a non-English application and submission of an English translation later than 30 months after the priority date, complete item IV(3).*

*NOTE: A non-English oath or declaration in the form provided or approved by the PTO need not be translated. 37 C.F.R. § 1.69(b).*

### **FEES**

**IV.**

1. Examination, Search and Additional Page Fee

**WARNING:** *The USPTO is considering changing the amount of the search fee and examination fee charged in national stage in the near future. Please refer to www.uspto.gov for the current fees.*

- Examination Fee
- Search Fee
- Additional Page Fee

*NOTE: See 37 C.F.R. § 1.28(a).*

2. Fees for claims

- each independent claim in excess of 3  
(37 C.F.R. § 1.492(d))—\$200.00; small entity—\$100.00 \$\_\_\_\_\_
- each claim in excess of 20  
(37 C.F.R. § 1.492(e))—\$50.00; small entity—\$25.00 \$\_\_\_\_\_
- multiple dependent claims(s)  
(37 C.F.R. § 1.492(f))—\$360.00; small entity—\$180.00 \$\_\_\_\_\_

3. Surcharge fees

- Surcharge for filing the oath or declaration later than thirty months from the priority date pursuant to § 1.495(c) and § 1.492(h): \$130.00; small entity—\$65.00 \$ 130.00

*NOTE: The processing fee in the next item 3 below is not subject to a reduction for small entity status.*

4.

For filing an English translation of an international application later than thirty months after the priority date (§ 1.495(c)) and § 1.492(i): \$130.00      \$ \_\_\_\_\_

**Total fees**      \$ \_\_\_\_\_

### **SMALL ENTITY STATUS**

V. a.  An assertion that this filing is by a small entity

NOTE: See 37 C.F.R. § 1.28(a).

(check and complete applicable items)

is attached.  
 was filed on \_\_\_\_\_.  
 was made by paying the basic national fee as a small entity.  
 is being made now by paying the basic national fee as a small entity.

b.  A separate refund request accompanies this paper.

### **EXTENSION OF TIME**

(complete (a) or (b), as applicable)

VI. The proceedings herein are for a patent application. Accordingly, the provisions of 37 C.F.R. § 1.136(a) apply.

(a)  Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a)(1)-(4), for the total number of months checked out below:

<input type="checkbox"/> one month	\$ 120.00	\$ 60.00
<input type="checkbox"/> two months	\$ 450.00	\$ 225.00
<input type="checkbox"/> three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/> four months	\$ 1,590.00	\$ 795.00

Fee: \$ \_\_\_\_\_

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

An extension for \_\_\_\_\_ months has already been secured. The fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

or

(b)  Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

2025 RELEASE UNDER E.O. 14176

### **TOTAL FEE DUE**

VII. The total fee due is:

Completion fee(s)	\$ 130.00
Extension fee (if any)	\$ _____

TOTAL FEE DUE \$ 130.00

**PAYMENT OF FEES****VIII.**

Attached is a  check  money order in the amount of \$ 130.00

Authorization is hereby made to charge ~~the amount of \$~~ \_\_\_\_\_  
 to Deposit Account No. 03-3420

to Credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should not be included on this form as it may become public.

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

**AUTHORIZATION TO CHARGE ADDITIONAL FEES****IX.**

**WARNING:** Accurately count claims, especially multiple dependant claims, to avoid unexpected high charges if extra claims are authorized.

**NOTE:** "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.136(a)(3).

**NOTE:** "Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

**NOTE:** The previous practice of holding applications abandoned if an authorization to charge fees under 37 C.F.R. § 1.16 has been provided instead of an authorization to charge fees under 37 C.F.R. § 1.492 has been changed. The Office amended 37 C.F.R. § 1.25(b), effective November 7, 2000, so that an authorization to charge fees under 37 C.F.R. § 1.16 in an international application entering the national stage under 35 U.S.C. § 371 is now accepted by the Office as an authorization to charge fees under 37 C.F.R. § 1.492.

Please charge, in the manner authorized above, the following additional fees that may be required by this paper and during the entire pendency of this application:

basic fee  
 presentation of extra claims  
 search fee  
 examination fee

**NOTE:** Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

- 37 C.F.R. § 1.17 (application processing fees)
- 37 C.F.R. § 1.17(a)(1)–(5) (extension fees pursuant to § 1.136(a)).
- 37 C.F.R. § 1.16(s) (additional fee for specification and drawings filed in paper over 100 sheets)
- 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b).

**NOTE:** Section 1.311(b) provides that an authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application only after the mailing of the notice of allowance. Accordingly, general authorizations to pay fees and specific authorizations to pay the issue fee that are filed prior to the mailing of a notice of allowance will generally not be treated as requesting payment of the issue fee and will not be given effect to act as a reply to the notice of allowance. Applicant, when paying the issue fee, should submit a new authorization to charge fees, such as by completing box 6b on the current PTOL-85B form. Where no reply to the notice of allowance is received, the application will stand abandoned notwithstanding the presence of general authorizations to pay fees or a specific authorization to pay the issue fee that were submitted prior to mailing of the notice of allowance. Where an attempt is made to pay the issue fee but an incorrect amount is submitted, § 1.311(b)(1), or where the Office's issue fee transmittal form (currently PTOL-85(B)) is completed by applicant and submitted, § 1.311(b)(2), in reply to a notice of allowance, an exception will be made. Such submissions will operate as a request to charge the issue fee to any deposit account identified in a previously filed (i.e., submitted prior to the mailing of the notice of allowance) authorization to charge fees, and will be allowed to act as payment of the correct issue fee, § 1.311(b). See also the change to § 1.26(b). Notice of September 8, 2000, Fed. Reg. 54603-54683, at 54646 and 54647.

**NOTE:** 37 C.F.R. § 1.28(b) requires "Notification of any change in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying . . . issue fee." From the wording of 37 C.F.R. § 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

- 37 C.F.R. § 1.492(e) and/or (f) surcharge fees for filing the declaration and/or an English translation of an international application later than 30 months from the earliest-claimed priority date.

**WARNING:** It would be wise to always check this last authorization.



**SIGNATURE OF PRACTITIONER**

**SCOTT R. COX**

(type or print name of practitioner)

**500 W. JEFFERSON ST., STE. 2100**

P.O. Address

**LOUISVILLE, KENTUCKY 40202**

EXPRESS MAIL NO. EQ 069676229 US



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/541,625	Heinz-Dieter Metzemacher	P-1263
INTERNATIONAL APPLICATION NO.		
PCT/EP04/00071		
I.A. FILING DATE	PRIORITY DATE	
01/08/2004	01/08/2003	
<b>CONFIRMATION NO. 8299</b>		
<b>371 FORMALITIES LETTER</b>		
 *OC000000018155542*		

Date Mailed: 03/01/2006 (VHT)

### **NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 07/06/2005
- English Translation of the IA filed on 07/06/2005
- Copy of the International Search Report filed on 07/06/2005
- Copy of IPE Report filed on 07/06/2005
- Copy of Annexes to the IPER filed on 07/06/2005
- Preliminary Amendments filed on 07/06/2005
- Information Disclosure Statements filed on 08/25/2005
- Request for Immediate Examination filed on 07/06/2005
- U.S. Basic National Fees filed on 07/06/2005
- Priority Documents filed on 07/06/2005
- Non-English Language Application filed on 07/06/2005
- Specification filed on 07/06/2005
- Claims filed on 07/06/2005
- Abstracts filed on 07/06/2005

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the

missing items identified in this letter.

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Surcharge.

Additionally the following defects have been observed:

- The translations of Annexes are canceled since the translations were not submitted prior to 30 months from the priority date.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

BARBARA A CAMPBELL

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Telephone: (703) 308-9140 EXT 217

PART 1 - ATTORNEY/APPLICANT COPY

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U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/541,625	PCT/EP04/00071	P-1263

FORM PCT/DO/EO/905 (371 Formalities Notice)